



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,775	10/02/2003	Stephane Christian Gasparini	CE50061P	9134
20280	7590	11/20/2006	EXAMINER	
MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			NGUYEN, KHOI	
			ART UNIT	PAPER NUMBER
			2196	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/677,775

Applicant(s)

GASPARINI ET AL.

Examiner

Khoi Nguyen

Art Unit

2196

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/02/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1-21 are pending in this application and presented for examination.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in WIPO on 03/25/2002 and 04/02/2001. It is noted, however, that applicant has not filed certified copies of the PCT/EP02/03417 and 01400835.3 application as required by 35 U.S.C. 119(b).

Drawing Objections

3. The drawing, Fig. 3 is objected to because of lacking on clarity. The directional line from step 8 to step 9 does not clearly disclose a directional indicator; thus, it can be interpreted as "bidirectional" as opposed to "one-way" communication. For the purpose of examination, this directional line will be interpreted as a communication flow from the authorization device to the client as step 8 and 9 are intended for.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended.

The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. The following claims are objected to for lack of antecedent basis.
 - a. "the received authentication key", claim 2, line 10. For the purpose of examining, the phrase "the received authorization key" would be treated as a different authorization key.

Art Unit: 2196

b. "the authorized feature set", claim 12, line 11. For the purpose of examining, the phase "the authorized feature set" would be treated as set of features that have been authorized to be used.

c. "the step of generating a local authorization key", claim 19, line 2. For the purpose of examining the phase "the step of generating a local authorization key" would be treated as generating an authorization key.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112 that form the basis for the rejections under this section made in this Office Action:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. With regard to claim 1, lines 4, 6, 10, 14, and 17 and claim 2, line 10, it is unclear whether the same or different entity is "forming a token", "receiving the token", "generate an authorization key", "receiving the feature change code" "generating a local authorization key", and "received authorization key" respectively.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 12, 15, and 20-21 are rejected under 35 U.S.C. 102(b) as being unpatentable over Manduley (US Pat No. 5,956,505).

10. With regard to claim 12, Manduley discloses a method of authorizing change in the available features in a software-implemented feature set containing a plurality of features (Abstract), comprising the steps:

receiving a token (Col. 7, lines 53-54, Fig. 4-A, step 206 - discloses a request code entered by the user and input into the data center which reads on token);

obtaining identification information and feature related information from the token (Col. 7, lines 62-65, Fig. 4-A, step 208 – discloses obtaining what program or features are requested and information identifying the device – which reads on identification information and feature related information).

in response to a determination to authorize change in the feature set, the further steps:

Using the identification information to generate an authorization key (Col. 6, lines 22-24 – discloses generating a code that represents the application or features or both for which activation is requested – which reads on authorization key);

forming a feature change code from the authorization key and information related to the authorized feature set (Col. 6, lines 45-48 –discloses an integrated request code that reflects entered ID and location data – which reads on feature change code, the software activation request and any hardware that is to be ordered – which reads on authorization key and information related to the authorized feature set); and

issuing the feature change code (Col. 8, lines 29-32 – discloses generating a code that will cause updating of activation map of the device to activate the requested features).

11. With regard to claim 15, Manduley discloses the identification information comprises data relating to at least one of a software identification number; a Device identification number; a Subscriber identification number (Col. 4, lines 43-47).

12. With regard to claim 20, Manduley discloses the token contains payment information in respect to the requested feature alteration (Col. 8, lines 24-28).
13. With regard to claim 21, Manduley discloses an apparatus for authorizing change in the available features in a software-implemented feature set containing a plurality of features (Abstract), comprising:
 - means for obtaining identification information and feature related information from the token (Col. 7, lines 62-65, Fig. 4-A, step 208)
 - means for determining to authorize change in the feature set (Fig. 3-C, step 124, Col. 6, line 2-3 – discloses that it is determined whether the user is authorized to request activation – which reads on determining authorize change in the feature set).
 - means for generating an authorization key using identification information (Col. 6, lines 22-24).
 - means for forming a feature change code from the authorization key and information related to the authorized feature set (Col. 6, lines 45-48); and

means for issuing the feature change code (Col. 8, lines 29-32).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 1-8, 10-11, 13-14, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley, in view of Barkan. (US Pat. No. 5,864,667).

16. With regard to claim 1, Manduley discloses a method of changing the available features in a software-implemented feature set containing a plurality of features (abstract), comprising the steps:

forming a token (Col. 6, lines 22-24) from identification information and feature related information (Col. 6, lines 10-11, Fig. 3C, step 126, discloses user is prompted to select the programs or feature – which reads on identification information and feature related information); and issuing the token (Col. 7, lines 25)

Art Unit: 2196

receiving the token (Col. 7, lines 53-54, Fig. 4-A, step 206) and obtaining identification information and feature related information from the token (Col. 7, lines 62-65, Fig. 4-A, step 208).

in response to a determination to authorize change in the feature set, the further steps:

Using the identification information to generate an authorization key (Col. 6, lines 22-24);

forming a feature change code from the authorization key and information related to the authorized feature set (Col. 6, lines 45-48); and issuing the feature change code (Col. 8, lines 29-32).

receiving the feature change code (Col. 6, lines 64-66, Fig. 3-D, step 146) and obtaining the authorization key (Col. 6, line 67) and information related to the authorized feature set from the feature change code (Col. 7, lines 2-5);

However, Manduley does not disclose generating a local authorization key using the identification information, comparing the received authorization key with the local authorization key and implementing the authorized feature set if the received authorization key and the local authorization key matched.

Art Unit: 2196

On the other hand, Barkan discloses generating a local authorization key (Col. 7, lines 1- 4 - private key, where private key reads on local authorization key).

In addition, Barkan further discloses comparing the received authorization key with the local authorization key (Col. 11, lines 49-50, key from distribution center would reads on received key) and implementing the authorized feature set if the received authorization key and the local authorization key match (Col. 11, lines 50-51, updating the local list reads on the true condition of the condition statement). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley and Barkan to facilitate secure communications between users having encryption machines over non-secured channel (Barkan, Col. 4, lines 44-49).

17. With regard to claim 2, Manduley discloses a method of changing the available features in a software-implemented feature set containing a plurality of features (abstract), comprising the steps:

forming a token (Col. 6, lines 22-24) from identification information and feature related information (Col. 6, lines 10-11, Fig. 3C, step 126); and issuing the token (Col. 7, lines 25).

receiving the feature change code (Col. 6, lines 64-66, Fig. 3-D, step 146) and obtaining the authorization key (Col. 6, line 67) and information related to the authorized feature set from the feature change code (Col. 7, lines 2-5);

However, Manduley does not disclose generating a local authorization key using the identification information, comparing the received authorization key with the local authorization key and implementing the authorized feature set if the received authorization key and the local authorization key matched.

On the other hand, Barkan discloses a method of generating a local authorization key (Col. 7, lines 1-4 - private key, where private key reads on local authorization key).

In addition, Barkan further discloses comparing the received authorization key with the local authorization key (Col. 11, lines 49-50, key from distribution center would reads on received key and implementing the authorized feature set if the received authorization key and the local authorization key match (Col. 11, lines 50-51, updating the local list reads on the true condition of the condition statement). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley and Barkan to facilitate secure communications between users having encryption machines over non-secured channel (Barkan, Col. 4, lines 44-49).

18. With regard to claims 3 and 4, Manduley discloses steps of forming the token (Col. 6, lines 22-24) but does not disclose using a random number to form a token. However, Barkan discloses an internal random numbers generator can be used to generate the key pair (Col. 13, lines 16-19). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley and Barkan to facilitates secure communications between users having encryption machines over non-secured channel (Barkan, Col. 4, lines 44-49).
19. With regard to claim 5, Manduley discloses the identification information comprises data relating to at least one of a software identification number; a Device identification number; a Subscriber identification number (Col. 4, lines 43-47).
20. With regard to claim 6 and 16, Manduley disclose identification information that contains data identifying device and its location data (Col. 4, lines 45-47) but does not disclose identification information comprises hardware version number or software version number data. However, Barkan discloses user downloads from the center a software package to generate an encryption key pair (Col. 5, lines 22-23, it is well known in the software development practice that each software package would included a version of the current released package). It

would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley and Barkan to facilitates secure communications between users having encryption machines over non-secured channel (Barkan, Col. 4, lines 44-49).

21. With regard to claim 7, Manduley discloses forming a token comprises the step of generating a code that represents the applications or feature or both for which activation is requested (Col. 6, lines 22-24, which reads on forming a token from identification data) but does not disclose forming a secret key and using the secret key as an encryption key to encrypt the feature related information. However, Barkan discloses a process of generating an encryption key pair (Col. 7, lines 4-5 – private key which reads on secret key and the private key is only used to decrypt or encrypt messages). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley and Barkan to facilitates secure communications between users having encryption machines over non-secured channel (Barkan, Col. 4, lines 44-49).
22. With regard to claim 8 and 18, Manduley discloses the step of generating a local authorization key (Col. 6, lines 21-24) but does not disclose steps of forming a secret key from identification data. On the other hand, Barkan discloses a process of generating an encryption key pair (Col. 13, lines 26-31 – private key

Art Unit: 2196

which reads on secret key). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley and Barkan to facilitates secure communications between users having encryption machines over non-secured channel (Barkan, Col. 4, lines 44-49).

23. With regard to claim 11, Manduley discloses an apparatus comprising:
- means for forming a token (Col. 6, lines 22-24) from identification information and feature related information (Col. 6, lines 10-11, Fig. 3C, step 126); and
 - means for issuing the token (Col. 6, lines 51-53)
 - means for receiving the feature change code (Col. 6, lines 64-66, Fig. 3-D, step 146)
 - means for obtaining the authorization key (Col. 6, line 67) and information related to the authorized feature set from the feature change code (Col. 7, lines 2-5);

However, Manduley does not disclose means for generating a local authorization key, means for comparing the received authorization key with the local authorization key and means for implementing the requested features if these authorized keys matched.

On the other hand, Barkan discloses a means for generating a key pair (a public and a private key) (Col. 7. lines 1- 4). Moreover, Barkan further discloses a

means for comparing the received authorization key with the local authorization key (Col. 11, lines 49-50) and a means for implementing the authorized feature set if the received authorization key and the local authorization key match (Col. 11, lines 50-51). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley and Barkan to facilitates secure communications between users having encryption machines over non-secured channel (Barkan, Col. 4, lines 44-49).

24. With regard to claim 13 and 14, Manduley discloses steps of receiving the token (Col. 7, lines 53-54, Fig. 4-A, step 206) and obtain information from the token but does not disclose obtaining a random number from a token. However, Barkan discloses a decryption process that decrypts the answer contains public key for the desired addressee and the group of random bits (Col. 7, lines 65-67). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley and Barkan to facilitates secure communications between users having encryption machines over non-secured channel (Barkan, Col. 4, lines 44-49).
25. With regard to claim 17, Manduley disclose the step of obtaining information from the token comprises the step of deriving a secret key and encrypted data from the received token (Col. 7, lines 61-63, discloses data center decrypts the

received request code in order to determined what programs or features are requested to be activated which reads on obtaining the secret key). Manduley, does not disclose using the secret key as a decryption key to decrypt the encrypted data to obtain feature related information.

However, Barkan discloses a method of decrypting the message from facility with caller's private key to extract a group of random bits (Col. 8, lines 18-20). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley and Barkan to facilitates secure communications between users having encryption machines over non-secured channel (Barkan, Col. 4, lines 44-49).

26. With regard to claim 10 Manduley discloses where token contain payment information in respect of the requested feature alteration (Col. 8, lines 24-28).
27. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley in view of Barkan, and further in view of En-Seung et al. (US. Pat. No. 6,892,306), hereafter "En-Seung".
28. With regard to claim 9, Manduley and Barkan disclose the step of generating a local authorization key but do not disclose using a non-reversible operation to generate the local authorization key. However, En-Seung discloses a hash

algorithm is used to generate the user's authorization information by using the user's key (Col. 5, lines- 62-64, hash algorithm which reads on non-reversible operation). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley, Barkan, and teachings of En-Seung to preserve transmission security of revenue bearing information while restricting access to the information by unauthorized entities and preventing unauthorized users from using any of the information that they may be able to illicitly obtain from the information provider (En-Seung, Col. 1, lines 63-67).

29. With regard to claim 19, Manduley does not disclose generating a local authorization key using the identification information. However, Barkan discloses generating a local authorization key (Col. 7, lines 1- 4). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley and Barkan to facilitates secure communications between users having encryption machines over non-secured channel (Barkan, Col. 4, lines 44-49).

Further more, both Manduley and Barkan do not disclose step of generating a local authorization key uses a non-reversible operation. On the other hand, En-Seung discloses a hash algorithm is used to generate the user's authorization information by using the user's key (Col. 5, lines- 62-64, hash algorithm which

reads on non-reversible operation). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention was made to combine the teachings of Manduley, Barkan, and teachings of En-Seung to preserve transmission security of revenue bearing information while restricting access to the information by unauthorized entities and preventing unauthorized users from using any of the information that they may be able to illicitly obtain from the information provider (En-Seung, Col. 1, lines 63-67).

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Patent No. (5,887,060) to Ronning.(Discloses method for preventing unauthorized duplication of the software program).
- b. U.S. Patent No. (5,509,070) to Schull (Discloses forming request software features, authorized request.).
- c. U.S. Patent No.(6,029,065) to Shah (Discloses registration process of mobile phone feature set with base stations)

Art Unit: 2196


d. U.S. PG Pub. (2002/0138770) to Dutta. (Discloses validation process through 3rd party on printed ticket containing security information).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi Nguyen whose telephone number is 570-270-1251. The examiner can normally be reached on M-Fri (7:30-5:00) Fri (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil E. El Hady can be reached on 571-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KN
Khoi Nguyen


NABIL M. EL-HADY
SUPERVISORY PATENT EXAMINER